REMARKS

Claims 1, 3 to 23, 28, 29 and 32 are pending in the application. No claims are amended, added or canceled herein.

Applicants acknowledge and thank the Examiner for his indication that the prior art rejections of record have been withdrawn.

The pending claims stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Specifically, it is stated in the Office Action that the claimed process/method is not patent eligible "in that it is not tied to another statutory class of invention in that no other statutory class of invention is positively recited in the claim and further the claim does not disclosing transforming subject matter to another state or thing." Applicant respectfully traverses the rejection.

Applicant has delayed responding to the instant rejection pending the release of the decision by the Court of Appeals for the Federal Circuit, sitting *en banc* in the matter of *In re Bilski*. That decision was released on October 30, 2008, and in clarifying the test for whether a claimed process or method defines statutory subject matter, has verified that the instant claims are patentable.

Specifically, the Court in *Bilski* adopted the test previously recited by the Supreme Court in *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972), stating that "[a] claimed process is surely patent eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *In re Bilski*, slip opinion at 10 (Fed. Cir. 2008). Thus, the Court held that even though the claimed process may involve a fundamental principle, so long as the claimed process uses a particular machine or apparatus, it would not pre-empt *all* uses of the fundamental principle such as those that do not use the specified machine or apparatus, and would thus be patentable. *Id.*, slip opinion at 11. In addition, the Court noted that even if a claim purportedly lacks any "physical steps," so long at it is tied to a machine, it "passes muster under § 101." *Id.*, slip opinion at 23.

Claim 1 of this application is directed to a method of selecting an unraced racehorse candidate having a better than average likelihood of becoming a high earner. The first step of the claimed method requires "ultrasonographically measuring the width of the ventricular septal wall of said racehorse candidate." In order to perform this step, one must use a

machine, specifically an ultrasound machine, to obtain the recited measurement of the width of the ventricular septal wall in the racehorse candidate. Thus, contrary to what is asserted in the Office Action, the claimed method is, indeed, "tied to another statutory class of invention," in that this step cannot be carried out without the use of an ultrasound machine.

Since the claims of the instant application all require the use of an ultrasound machine to perform at least one step of the claimed method, Applicant respectfully submits that the claims "pass muster under § 101" per the test recited by the Court of Appeals for the Federal Circuit. Accordingly, Applicant respectfully requests withdrawal of the pending rejection under § 101, and allowance of all of pending claims 1, 3 to 23, 28, 29 and 32.

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